

Claim 1 recites that the majority of the length of the fingers of the first rotor overlaps with the adjacent fingers of the second rotor. The Examiner states that an arrangement where a majority of the length of the fingers of the first rotor overlaps with the adjacent fingers of the second rotor is disclosed in Figures 1-2 of Wulff et al. ('445), or in Figures 1-6 of Wulff et al. ('087), or in Figure 18 of Terada et al. Based on this, the Examiner concludes it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Thale with either of the Wulff patents or Terada et al., because such a combination would provide for improved pulp fluffing in the apparatus of Thale.

The Thale patent teaches the purpose of his invention is to provide an arrangement in a machine where the risk of nodules being formed during the shredding process is essentially reduced. (See Col. 1, lines 49-52.) Thale continues by explaining that this purpose is achieved by the fact that the depth of engagement between the toothings of the shredding roller and those of the holding member is not more than half the length of the shredding roller teeth. (See Col. 1, lines 53-56.)

The Examiner is respectfully reminded that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); see M.P.E.P. § 2143.01.V., p. 2100-137, rev. 3, Aug. 2005. Because the very reference being modified teaches that the intended purpose is achieved by the depth of engagement being not more than half the length of the teeth, the corollary is that the purpose is not achieved by the depth of engagement being greater than half the length. Therefore, it is undeniable that the modification would render the prior art invention being modified unsuitable for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification.

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The Examiner is respectfully reminded that "to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). See M.P.E.P. § 2142, p. 2100-134, rev. 3, Aug. 2005.

The suggestion or motivation to do what is recited in Claim 1 is simply not found in the references or generally known. While Wulff et al. ('445) and Wulff et al. ('087) describe a mixer/dryer 2 appearing to have kneading disks 16, the Wulff patents are related to a process for drying polymeric powders and polymeric agglomerates, in particular, thermoplastic aromatic polycarbonate or other thermoplastic polymers. (See the abstracts.) The Terada et al. patent is related to disintegration of used paper into long pulp fibers without tearing it mechanically. (See the abstract.) The Thale patent is directed to a method of shredding or fluffing ground wood. (See the abstract.) Furthermore, the Thale patent explicitly teaches at Col. 1, lines 53-56, that "according to the invention, this purpose is achieved by the fact that the depth of the engagement between the toothings of the shredding roller and those of the holding member is not more than half the length of the shredding roller teeth." The Examiner is respectfully reminded that the Examiner must take into consideration all the evidence, which in this case consists of an explicit teaching from the very reference being modified that weighs against the modification. Furthermore, the Examiner must provide evidence which, as a whole, shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. See M.P.E.P. § 2142, p. 2100-134, rev. 3, Aug. 2005.

At most, the Examiner has put forth references unrelated with the problem faced by Thale. The only other evidence offered by the Examiner is the vague and unsupported statement

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that such a combination would provide for improved pulp fluffing in the apparatus of Thale. However, there is simply no evidence to support this statement, and furthermore Thale teaches the contrary.

The Prior Art References Do Not Teach or Suggest All the Claim Limitations

A *prima facie* rejection requires that the prior art references teach or suggest all the claim limitations. The Wulff et al. patents ('445 and '087) do not teach or suggest the fingers of the first rotor overlap with the fingers of the second rotor as claimed. While the Examiner states that Figures 1-2 of Wulff et al. ('445) and Figures 1-6 of Wulff et al. ('087) disclose such limitation, this is simply not correct. Figure 4a of Wulff et al. ('445) and Figure 8a of Wulff et al. ('087) show the apparatus more clearly. In Figure 4a, a kneading disc 16 is shown on the shaft 11, wherein the kneading disc 16 is only minimally overlapping with a kneading bar 17. See Wulff '445 at column 7, lines 60-65. The overlapping section appears to be only the amount shown by the dotted lines. The same description applies to Figure 8a, wherein the kneading disc 11 is shown on the shaft 21, wherein the kneading disc 11 is minimally overlapping with the kneading bar 30.

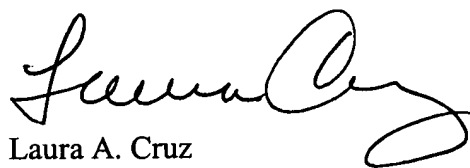
Accordingly, the Wulff et al. patents ('445 and '087), at the very least, do not teach or suggest the fingers of the first rotor overlap with the fingers of the second rotor as claimed.

CONCLUSION

In view of the foregoing remarks, applicants submit that the *prima facie* rejection of obviousness is insufficient for at least lacking a suggestion or motivation. Accordingly, the withdrawal of the rejection and allowance of Claims 1-7 is respectfully requested. If the Examiner has any further questions or comments, the Examiner may contact the applicants' attorney at the number provided below.

Respectfully submitted,

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